

REMARKS

Claims 1 to 47 are pending in this application and are subject to restriction under 35 U.S.C. § 121, as follows:

Group	Claims	Subject Matter	Class
I	Claims 1, 3 to 32, and 34	Drawn to a compound of formula (I)	548
II	Claim 2	Drawn to a compound of formula (II) or (III)	548
III	Claim 33	Drawn to a method of inhibiting plasminogen activator	514
IV	Claims 35 to 47	Drawn to a method of treatment	514

It is asserted that the inventions of Groups I to IV are independent and distinct. A requirement has also been made for an election of a single compound in any group elected.

According to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05-§ 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

For purposes of the initial requirement, a serious burden may be *prima facie* shown if the examiner shows separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. In the subject application, the claims have been restricted into four different groups, however, ***Groups I and II are classified in Class 548 and Groups III and IV are classified in Class 514.*** Thus, applicants respectfully submit that a *prima facie* case of serious burden has not been established for more than two groups.

While applicants do not believe that a proper requirement for restriction has been established, applicants believe that any restriction among the members of the Markush groups within the claims should only be made *provisionally*. MPEP § 803.02, which addresses restriction practice with respect to Markush-type claims, clearly sets forth that the Examiner

may only require a *provisional* election of a single species prior to examination on the merits. The provisional election would be given effect in the event that the Markush-type claim was found not to be allowable. Following election, the Markush-type claim would be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim were not allowable over the prior art, examination would be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. However, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.

The MPEP provides an example in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E. With such a claim, the examiner may require a *provisional* election of a single species (CA, CB, CC, CD, or CE). The Markush-type claim is then examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If, on examination, the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species would be rejected, and claims to the non-elected species would be held withdrawn from further consideration. On the other hand, if no prior art anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.

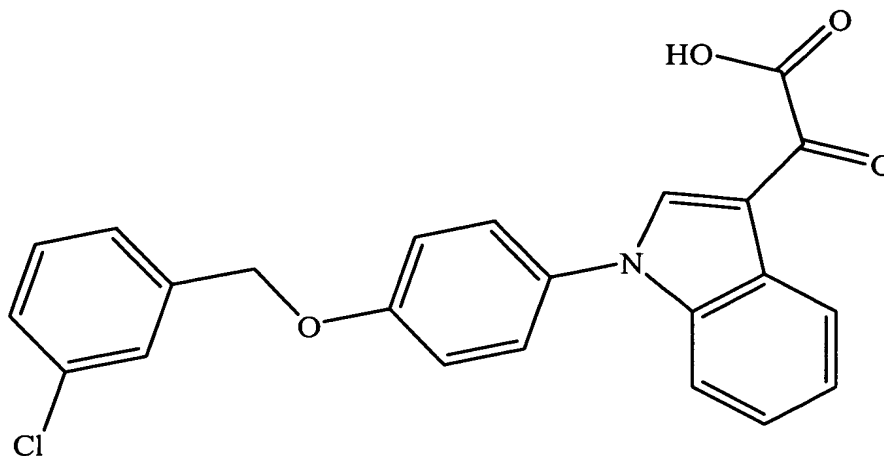
Applicants submit that the compounds of Group II are a subset of the compounds of Group I. Thus, it appears that any search of Group I will also reveal all relevant art for Group II. Accordingly, applicants request reconsideration of the restriction between Groups I and II.

Thus, applicants respectfully request reconsideration of the requirement for restriction, and in particular an indication that the requirement is only a provisional election for the purpose of carrying out the search. Nonetheless, to be fully responsive to the restriction requirement, applicants elect *with traverse* to prosecute the claims of **Group I**.

Further, applicants elect *with traverse* the compound of **Example 3**:

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PATENT



{1-[4-(3-chloro-benzyloxy)-phenyl]1H-indol-3-yl}-oxo-acetic acid

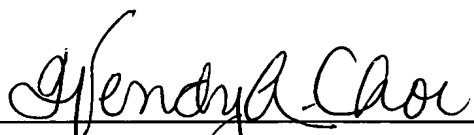
This compound is readable on claims 1 (generic claim), 2 (subgeneric claim), and 5 (species claim), as well as method claims 33 to 47.

It is applicants' understanding that the process claims of Groups III and IV will be rejoined with the product claims of Group I and/or Group II, if the process claims of Groups III and IV are commensurate in scope with allowed product claims.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (404) 459-5642.

Applicants request that the Office send a copy of the initialled PTO-1449 forms submitted with the Information Disclosure Statements mailed March 5, 2004, August 3, 2004, September 2, 2005, November 7, 2005, and December 12, 2005.

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